

REMARKS

Claims 2; 3; 7; 8; 13; 16; 19; 20; 24; 25; and 29 to 36 remain in the application as previously presented. Of these, claims 2 and 32 are independent system claims.

Reexamination and reconsideration are respectfully requested in view of the amendments and the remarks that follow.

Claims 2; 3; 7; 8; 13; 16; 19; 20; 24; 25 stand rejected under 35 U.S.C. § 103(a) based upon Scholten et al (US 5,108,404) in view of Preissman (US 6,383,190) (the Preissman Patent). The Examiner acknowledges that Scholten does not teach or suggest an auxiliary tool, as defined in independent claims 2 and 32, that is sized and configured to be advanced through the interior bore of a nozzle (which itself passes through an access path established through soft tissue to bone), to urge filling material in a measured way from the nozzle. The Examiner relies upon the Preissman Patent as teaching the use of an auxiliary tool to apply pressure to an implantable material to deliver the material. The Examiner combines the Preissman Patent with Scholten.

The applicant respectfully traverses these rejections.

The instant application claims the benefit as a second-generation divisional application to a grandparent application, Serial No. 09/134,323, filed August 14, 1998 (now US 6,241,734). The Preissman Patent was filed September 30, 1999, which is after the priority date of the instant application. However, the Preissman Patent claims continuation-in-part status to an application (Serial No. 09/053,108) filed April 1, 1998 (now abandoned) (the '108 Application), which is before the priority date of the instant application. The applicant attaches a courtesy copy of the '108 Application to aid the Examiner in the following discussion.

A comparison of the subject matter disclosed in the earlier '108 Application to the subject matter disclosed in the later Preissman Patent shows that the Preissman Patent is entitled to the benefit of a priority date of April 1, 1998 (which is earlier than the filing date of the instant application) only with respect to the disclosure of a pressure applicator that generates pressure by screwing one column 56 over another column 54 (see, e.g., Fig. 6 in the '108 Application and Fig. 6 in the Preissman Patent) – because this disclosure finds support in the earlier filed '108 Application. This disclosure, however, does not teach or suggest the subject matter of claims 2 and 32, which is an auxiliary tool that is sized and configured to be advanced through the interior bore of a nozzle

(which itself passes through an access path established through soft tissue to bone), to urge filling material in a measured way from the nozzle.

With respect to the additional disclosure in the Preissman Patent of a plunger advanced through a column (see, e.g., in Fig. 7 of the Preissman Patent), the Preissman Patent is not entitled to a priority date earlier than the filing date of the instant application -- because this subject matter is not disclosed in the '108 Application. Instead, this subject matter is entitled to the later filing date of the Preissman Patent of September 30, 1999, which is after the April 14, 1998 priority date of the instant application. The Preissman Patent is not prior art to the instant application with respect to this later-added subject matter.

For these reasons, Applicant respectfully asks the Examiner to withdraw his rejections based upon Scholten and the Preissman Patent. Neither Scholton nor the Preissman Patent teaches or suggests an auxiliary tool that is sized and configured to be advanced through the interior bore of a nozzle (which itself passes through an access path established through soft tissue to bone), to urge filling material in a measured way from the nozzle, as defined in claims 2 and 32.

The Examiner attention is directed to the following:

(1) Reexamination Serial No. 90/007,937, filed February 10, 2006, pending before Examiner David D. Reip (Art Unit 3993), regarding US 6,241,734 (the grandparent of the instant application).

(2) Reexamination Serial No. 90/007,938, filed February 10, 2006, pending before Examiner David D. Reip (Art Unit 3993), regarding US 6,613,054 (the parent of the instant application).

(3) The attached Supplemental Information Disclosure Statement, which makes of record documents cited in the Reexaminations (1) and (2), as well as additional documents the applicant seeks to make of record in the instant application.

Applicant respectfully submits that claims 2; 3; 7; 8; 13; 16; 19; 20; 24; 25; and 29 to 36 stand in condition for allowance.

Respectfully Submitted,
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